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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,332	09/10/2004	Larry G. Tang	PU2247	5331
23454	7590	01/12/2005		
CALLAWAY GOLF COMPANY 2180 RUTHERFORD ROAD CARLSBAD, CA 92008-7328				
EXAMINER PASSANITI, SEBASTIANO				
ART UNIT			PAPER NUMBER	
3711				

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/711,332

Applicant(s)

TANG ET AL.

Examiner

Sebastiano Passaniti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

This Office action is responsive to communication received 09/10/2004 – application papers filed.

A complete summary of the parent continuation chain is listed on the application data sheet. A listing of the parent files will not be presented here, for brevity.

Claims 1-40 are pending.

Following is an action on the MERITS:

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 6, 12, 15-17, 25, 28, 29, 31 and 37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,793,588. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '588 Patent are more specific than the instant claims and therefor encompass all of the limitations of the instant claimed invention. Specific to instant claim 1, note claim 1 of the '588 Patent. As to instant claim 2, note claim 2 of the '588 Patent. As to instant

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claim 3, see claim 3 of the '588 Patent. As to instant claim 4, see claim 4 of the '588 Patent. As to instant claim 6, note claims 8 and 9 of the '588 Patent, both of which recite a "grip". As to instant claim 15, see claim 2 of the '588 Patent. As to instant claim 16, see claim 3 of the '588 patent. As to instant claim 17, see claims 4, 7 and 9 of the '588 Patent. As to instant claim 19, see claims 8 and 9 of the '588 Patent. As to instant claim 28, see claim 7 of the '588 Patent. As to instant claim 29, see claim 3 of the '588 Patent. As to instant claim 31, see claims 8 and 9 of the '588 Patent. As to claims 12, 25 and 37, see claims 8 and 9 of the '588 Patent.

Claims 8, 10, 21, 23, 33 and 35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,793,588 in view of Barnhardt. To have modified the claimed invention of the '588 device by including a shaft having the instant claimed length for the purpose of accommodating a pendulum swing or just simply accommodating a tall golfer would have been obvious in view of the patent to Barnhardt, which shows it to be old in the art to provide a shaft having a length of between 38 and 46 inches (see claim of Barnhardt).

Claims 5, 18, 30 and 40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,793,588 in view of Dalton. To have modified the claimed invention of the '588 Patent to include an insert in the face and more particularly an insert in the face formed of polyurethane material in order to produce a desired rebound effect when striking a golf ball would have been obvious in view of the patent to Dalton, which shows

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it to be old in the art to include an insert (30) made of any suitable material that provides the required rebound characteristics (col. 4, lines 10-16 in Dalton). The selection of a specific material for the insert would have involved a matter of design choice, since the skilled artisan would have known which material(s) to select based upon the properties of known, suitable materials. See In re Hopkins 145 USPQ 140.

Claims 7, 14, 20, 27, 32 and 39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,793,588 in view of Turner. To have modified the claimed invention of the '588 Patent to include a cylindrical rod extending upward from the crown, i.e., a hosel extending upwardly from the crown, for enabling the shaft to be inserted therein along with incorporating one of the claimed metal materials in the manufacture of the club head body to take advantage of the properties of materials known in the art, i.e., to take advantage of properties such as weight and strength, would have been obvious in view of the patent to Turner, which shows it to be old in the art to connect a shaft to the head via hosel (14) and further shows the use of any one of a plethora of conventional materials for the material make-up of the head (see col. 2, line 34 through col. 5, line 2 in Turner).

Claims 13, 26 and 38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,793,588 in view of Pelz. While the claimed invention of the '588 Patent describes alignment means, no mention is made of circular inserts. To have modified the claimed device of the '588 Patent to include circular inserts in an effort to better

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assist a golfer to align a golf ball with the putter head at address would have been obvious in view of the patent to Pelz, which shows it to be old in the art to use a plurality of circular-styled alignment means on the crown surface to enhance the alignment capabilities of the putter head.

Claims 9, 11, 22, 24, 34 and 36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,793,588. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed weight is merely deemed to be an obvious variation over the 275-400 gram range outlined in claims 7-9 of the '588 Patent. Note, the '588 Patent only requires two restrictions to help establish a lower limit for the weight of the head, that is, that the swing static balance is over 500 grams-centimeters and that 70 percent of the mass of the head is in the central section. There is no upper limit placed on how maximum weight for the head. The skilled artisan would have found it obvious to modify the weight based upon player preference.

It is noted that a similar set of rejections may be set forth with respect to U.S. Patent 6,679, 782. While the primary rejection statements will be set forth below, a complete exposition of the explanation for each rejection will not be presented here for brevity, especially for the rejections of claims 1-4, 6, 12, 15-17, 25, 28, 29, 31 and 37. Applicant's diligence in referring to the comments incorporated supra with respect to the rejection of the claims based upon the previous '588 Patent is respectfully requested.

Claims 1-4, 6, 12, 15-17, 25, 28, 29, 31 and 37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over

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claims 1-11 of U.S. Patent No. 6,679, 782. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '782 Patent are more specific than the instant claims and therefor encompass all of the limitations of the instant claimed invention.

Claims 8, 10, 21, 23, 33 and 35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,679,782 in view of Barnhardt. To have modified the claimed invention of the '782 device by including a shaft having the instant claimed length for the purpose of accommodating a pendulum swing or just simply accommodating a tall golfer would have been obvious in view of the patent to Barnhardt, which shows it to be old in the art to provide a shaft having a length of between 38 and 46 inches (see claim of Barnhardt).

Claims 5, 18, 30 and 40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,679,782 in view of Dalton. To have modified the claimed invention of the '782 Patent to include an insert in the face and more particularly an insert in the face formed of polyurethane material in order to produce a desired rebound effect when striking a golf ball would have been obvious in view of the patent to Dalton, which shows it to be old in the art to include an insert (30) made of any suitable material that provides the required rebound characteristics (col. 4, lines 10-16 in Dalton). The selection of a specific material for the insert would have involved a matter of design choice, since the

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skilled artisan would have known which material(s) to select based upon the properties of known, suitable materials. See In re Hopkins 145 USPQ 140.

Claims 7, 14, 20, 27, 32 and 39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,679,782 in view of Turner. To have modified the claimed invention of the '782 Patent to include a cylindrical rod extending upward from the crown, i.e., a hosel extending upwardly from the crown, for enabling the shaft to be inserted therein along with incorporating one of the claimed metal materials in the manufacture of the club head body to take advantage of the properties of materials known in the art, i.e., to take advantage of properties such as weight and strength, would have been obvious in view of the patent to Turner, which shows it to be old in the art to connect a shaft to the head via hosel (14) and further shows the use of any one of a plethora of conventional materials for the material make-up of the head (see col. 2, line 34 through col. 5, line 2 in Turner).

Claims 13, 26 and 38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,679,782 in view of Pelz. While the claimed invention of the '782 Patent describes alignment means, no mention is made of circular inserts. To have modified the claimed device of the '588 Patent to include circular inserts in an effort to better assist a golfer to align a golf ball with the putter head at address would have been obvious in view of the patent to Pelz, which shows it to be old in the art to use a plurality

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of circular-styled alignment means on the crown surface to enhance the alignment capabilities of the putter head.

Claims 9, 11, 22, 24, 34 and 36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,679,782. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claimed weight is not deemed critical. Note, the '588 Patent only requires two restrictions to help establish a lower limit for the weight of the head, that is, that the swing static balance is over 500 grams-centimeters and that 70 percent of the mass of the head is in the central section. There is no upper limit placed on how maximum weight for the head. The skilled artisan would have found it obvious to modify the weight based upon player preference.

Of further interest is the fact that two other Patents (U.S. 6,471,600 and U.S. 6,506,125) include claimed subject matter that is related to the instant invention. While there would not appear to be any double patenting issues to raise at the present time, applicant is respectfully urged to review the claims of the '600 and '125 Patents to ensure that a clear line of demarcation is maintained among all of the claims in these Patents and the instant claims being examined.

Enclosed with this Office action is a sample terminal disclaimer which is effective to overcome an obviousness-type double patenting rejection over a prior patent (37 CFR 1.1321(b) and (c)).

Also enclosed is a sample Statement Under 37 CFR 3.73(b) (Form PTO/SB/96) which an assignee may use in order to ensure compliance with the rule. Part A of the Statement is used when there is a single assignment from the inventor(s). Part B of the Statement is used when there is a chain of title. The "Copies of assignments..." box should be checked when the assignment document(s) (set forth in part A or part B) is/are not recorded in the Office, and a copy of the assignment document(s) is/are

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attached. When the "Copies of assignments..." box is checked, either the part A box or the part B box, as appropriate, must be checked, and the "Reel____, Frame____" entries should be left blank. If the part B box is checked, and copies of assignments are not included, the "From:____ To:____" blank(s) must be filled in. This statement should be used the first time an assignee seeks to take action in an application under 37 CFR 3.73(b), e.g., when signing a terminal disclaimer or a power of attorney.

All references cited during the prosecution of each of applicant's parent files are deemed pertinent to this instant application and are incorporated herein by reference.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sebastiano Passaniti
Primary Examiner
Art Unit 3711

S.Passaniti/sp
January 10, 2005

PTO/SB/26 (10-00)

Approved for use 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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TERMINAL DISCLAIMER TO OBTAIN A DOUBLE PATENTING REJECTION OVER A PRIOR PATENT	Docket Number (Optional)
<p>In re Application of:</p> <p>Application No.:</p> <p>Filed:</p> <p>For:</p> <p>The owner*, _____, of _____ percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. _____. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.</p> <p>In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.</p> <p>Check either box 1 or 2 below, if appropriate.</p> <p>1. <input type="checkbox"/> For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.</p> <p>I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.</p> <p>2. <input type="checkbox"/> The undersigned is an attorney or agent of record.</p> <div style="text-align: right; margin-top: 20px;"> <div style="display: inline-block; width: 45%; border-bottom: 1px solid black; margin-bottom: 5px;"></div> <div style="display: inline-block; width: 45%; border-bottom: 1px solid black; margin-bottom: 5px;"></div> <div style="display: flex; justify-content: space-between; width: 100%; font-size: small;"> Signature Date </div> <div style="border-top: 1px solid black; margin-top: 10px; text-align: center; width: 100%;"> Typed or printed name </div> </div> <p><input type="checkbox"/> Terminal disclaimer fee under 37 CFR 1.20(d) included.</p> <p style="text-align: center; font-size: small;">WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</p> <p style="font-size: x-small;">*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner). Form PTO/SB/96 may be used for making this certification. See MPEP § 324.</p>	

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box Patent Application, Washington, DC 20231.

CERTIFICATE UNDER 37 C.F.R. § 3.73(b)

Applicant: _____

Application No.: _____ Filed: _____

For: _____

_____, a _____
(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

certifies that it is the assignee of the entire right, title and interest in the patent application identified above by virtue of either:

A. ☐ An assignment from the inventor(s) of the patent application identified above. The assignment was recorded in the Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

OR

B. ☐ A chain of title from the inventor(s), of the patent application identified above, to the current assignee as shown below:

1. From: _____ To: _____
The document was recorded in the Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.

2. From: _____ To: _____
The document was recorded in the Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.

3. From: _____ To: _____
The document was recorded in the Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

☐ Copies of assignments or other documents in the chain of title are attached.

The undersigned has reviewed all the documents in the chain of title of the patent application identified above and, to the best of undersigned's knowledge and belief, title is in the assignee identified above.

The undersigned (whose title is supplied below) is empowered to act on behalf of the assignee.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date : _____

Name : _____

Title : _____

Signature: _____